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F3M1/0226

EXAMINER	
KOO, B	
ART UNIT	PAPER NUMBER
3301	25

DATE MAILED:

02/26/97

**Please find below a communication from the EXAMINER in charge of this application.**

Commissioner of Patents

# Office Action Summary

Application No.

08/451,652

Applicant(s)

Deloris G. Wood

Examiner

Benjamin Koo

Group Art Unit

3301



☒ Responsive to communication(s) filed on Dec 3, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 23-46 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 23, 24, 28-32, 36-40, and 42-46 is/are rejected.

☒ Claim(s) 25-27, 33-35, and 41 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 18 and 21

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23, 24, 28, 31, 32, 36, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Laguerre '321 for the same reasons set forth in the previous office action, paper no. 22, paragraph 3.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laguerre '321 for the same reasons set forth in the previous office action, paper no. 22, paragraph 5.

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5.

Claims 29, 37, 40, 42-45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laguerre in view of Rubin et al. '456 for the same reasons set forth in the previous office action, paper no. 22, paragraph 6.

*Allowable Subject Matter*

6. Claims 25-27, 33-35, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not show the specific heart shaped frame as claimed by the applicant.

8. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

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***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 3772707, 4837861, and 5112322. British Patent 948667 and German Patent 3920996.

***Response to Arguments***

11. Applicant's arguments filed 12/3/96 have been fully considered but they are not persuasive.

In response to applicant's argument that the Laguerre reference is not analogous and used for a different purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of

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performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant is reminded that with regard to article claims, only structural limitations will be taken in consideration, if applicant feels that the invention primarily lies in the intended use and function, it is advised that the applicant submit method claims to better recite such limitations.

With regard to applicant's arguments stating that the Laguerre reference has too many layers in order for it to be effective, the applicant's claim only calls for "a membrane" and Laguerre shows a non-rigid, plastic bag which has met the applicant's structure, furthermore the use of plastic material would inherently provide a barrier to microorganisms.

In response to applicant's arguments, the recitation of the use of the device for preventing the exchange of microorganisms between two persons engaged in the act of kissing or french kissing has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 88 USPQ 478, 481 (CCPA 1951).

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Ben Koo whose telephone number is (703) 308-2657.

*Michael A. Brown*

MICHAEL A. BROWN  
PRIMARY EXAMINER  
GROUP 3300

bk

February 20, 1997